

REMARKS/ARGUMENTS

In the restriction requirement mailed April 10, 2008, the Examiner delineated the following inventions as being patentably distinct:

- Group I: Claims 1-8, drawn to a process for preparing a surfactant-free suspension;
- Group II: Claims 9-12, drawn to an aqueous suspension prepared by the above method;
- Group III: Claim 13, drawn to a dirt and water-repellant coating comprising the above suspension;
- Group IV: Claims 14-17, drawn to a process for preparing a dirt and water-repellant coating by applying the suspension as prepared above;
- Group V: Claim 18, drawn to an article having a water-repellant coating;
- Group VI: Claims 19-23, drawn to a protective coating; and
- Group VII: Claim 24, drawn to a spray comprising the suspension.

Applicants provisionally elect, with traverse the invention of Group II, Claims 9-12, drawn to an aqueous suspension prepared by the method of Group I.

The claims of Groups I-VII are integrally linked as process, product, and the method of using.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. Restriction between a product, process for making said product and the use thereof is proper when the product can be made by another method. Applicants respectfully traverse the restriction requirement on the ground that the Examiner has not

provided sufficient reasons or examples to support patentable distinctiveness. Final product method of making and the use thereof are inter dependent and should be examined together on the merits, especially wherein the sole disclosed utility of the product is that recited in the specification. Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility composition, method of making and the use thereof are considered related inventions under 37 C.F.R. § 1.475(b), and unity of invention between the groups exists. Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to ... (3) a product, process especially adapted for the manufacture of said product, and use of said product.” Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as other claims. It does not matter if a dependent claim itself contains a further invention.


For the reasons recited above, applicants request that the restriction requirement be withdrawn.

Divisional applications filed thereafter claiming the non-elected subject matter should not be subject to double patenting ground of rejection. 35 U.S.C. § 121, *In re Joyce* (Comr. Pats. 1957) 115 USPQ 412.

Applicants submit that the above identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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